

### **REMARKS**

In the Office Action mailed July 14, 2008, the Examiner rejected claims 21-39, 41-45, 47-68, 70-78, 123, and 124 under 35 U.S.C. § 101<sup>1</sup>; rejected claims 21-39, 41-45, 47-68, 70-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 112, first paragraph<sup>2</sup>; rejected claims 50-68, 70-97, 99-103, 105-107, 124, and 125 under 35 U.S.C. § 112, second paragraph<sup>3</sup>; rejected claims 21-27, 50-56, 79-85, and 123-125 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,021,397 to Jones et al (hereinafter, "Jones"); and rejected claims 28-39, 41-45, 47-49, 57-68, 70-78, 86-97, 99-103, and 105-107 under 35 U.S.C. §103(a) as being unpatentable over Jones.

By this response, Applicants hereby amend claims 21-39, 41-45, 47-68, 70-74, 76-79, 81-91, 93-97, 99-103, 105-107, and 123-125. Claims 1-20, 40, 46, 69, 75, 98, 104, and 108-122 were previously canceled. No new matter has been added. Accordingly, claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-125 are currently pending.

In light of the foregoing amendments and based on the reasoning presented below, Applicants respectfully traverse the rejections of claims 21-39, 41-45, 47-68, 70-

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<sup>1</sup> While the Office Action states that claims 21-39, 41-45, 47-68, 69-78, 123, and 124 are rejected under 35 U.S.C. § 101, Applicants note that claim 69 had been canceled by a previous amendment. Therefore, Applicants believe the Examiner intended the § 101 rejection to apply to claims 21-39, 41-45, 47-68, 70-78, 123, and 124, and Applicants respond herein accordingly.

<sup>2</sup> While the Office Action states that claims 21-39, 41-45, 47-68, 69-97, 99-103, 105-107, and 123-125 are rejected under 35 U.S.C. § 112, first paragraph, Applicants note that claim 69 had been canceled by a previous amendment. Therefore, Applicants believe the Examiner intended the § 112, ¶ 1, rejection to apply to claims 21-39, 41-45, 47-68, 70-97, 99-103, 105-107, and 123-125, and Applicants respond herein accordingly.

<sup>3</sup> While the Office Action states that claims 50-68, 69-97, 99-103, 105-107, 124, and 125 are rejected under 35 U.S.C. § 112, second paragraph, Applicants note that claim 69 had been canceled by a previous amendment. Therefore, Applicants believe the Examiner intended the § 112, ¶ 2, rejection to apply to claims 50-68, 70-97, 99-103, 105-107, 124, and 125, and Applicants respond herein accordingly.

74, 76-97, 99-103, 105-107, and 123-125 under 35 U.S.C §§ 101, 102(e), 103(a), 112, first paragraph, and 112, second paragraph, and request allowance of the pending claims.

**I. Examiner's Response to Arguments**

As a preliminary matter, Applicants respectfully note that the Examiner's response to Applicants' arguments and the rejection of the claims fails to meet the standards identified in 35 U.S.C. § 102. Specifically, the Examiner's reliance upon the doctrine of *res judicata* for showing anticipation is misplaced in that the Board of Patent Appeals and Interferences was never presented with the current form of independent claim 21, and therefore did not rule on the elements of claim 21 as they are currently recited.

Specifically, the Examiner states that "[i]n its February 28, 2008 decision, the Board affirmed the Examiner on dependent claims 25 [adjustable time indicia], 26 [adjustable quality indicia], and 27 [adjustable time and quality indicia], thereby rendering the anticipation of these elements *res judicata*." Office Action, p. 3. However, this is a misapplication of the Board's decision. That is, although the Board considered dependent claims 25, 26, and 27, as they separately depended from independent claim 21, independent claim 21 has been amended to include recitations that have a scope different from that of dependent claims 25, 26, or 27 as considered by the Board.

Moreover, section 706.03(w) of the M.P.E.P., which discusses the doctrine of *res judicata*, highlights several examples where a rejection using the doctrine of *res judicata* was reversed by the United States Court of Customs and Patent Appeals (CCPA), the predecessor to the United States Court of Appeals for the Federal Circuit (CAFC). For

example, the M.P.E.P. cites In re Fried, 312 F.2d 930, 136 USPQ 429 (CCPA 1963), In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963), In re Hellbaum, 371 F.2d 1022, 152 USPQ 571 (CCPA 1967), and In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970), as having been reversed by the CCPA. The cited reason for reversing each of these *res judicata*-based rejections was “differences in claims.” M.P.E.P. § 706.03(w).

For the same reason, the Examiner’s application of *res judicata* in this application is legally unsupportable. Instead of ruling on the current recitations of amended independent claim 21, the Board addressed a) claim 25, which then and still depends from amended independent claim 21, b) claim 26, which then and still depends from amended independent claim 21, and c) claim 27, which then and still depends from amended independent claim 21. Thus, there are clear differences in the claims considered by the Board and the currently pending claims.

Therefore, the Board did not rule on the current recitations of independent claim 21, and the Examiner cannot rely on the doctrine of *res judicata* to reject independent claim 21.

## **II. Response to Amendment**

In the Office Action, the Examiner stated that “[t]he amendment filed April 28, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure.” Office Action, p. 2. In addition, the Examiner stated that “Applicant is required to cancel the new matter in reply to this Office Action.” Id. at p. 3.

Applicants respectfully disagree with the Examiner’s statements at least because Applicants made no amendments to the specification in the Reply filed April 28, 2008 (hereinafter, “Reply”). Indeed, it appears that the Examiner has mistakenly used Form

Paragraph 7.28, "*Objection to New Matter Added to Specification*" in an attempt to object to the claim amendments. M.P.E.P. 706.03(o). Specifically, the Examiner referred to the "§ 112, ¶ 1 rejection" in an attempt to identify the alleged new matter, and failed to identify any alleged new matter in the specification. Office Action, p. 3.

Accordingly, because Applicants have not added subject matter to the Specification, Applicants respectfully decline to cancel any subject matter out of the Specification.

## **II. Rejection under 35 U.S.C. § 101**

The Examiner rejected claims 21-39, 41-45, 47-68, 70-78, 123, and 124 under 35 U.S.C. § 101, alleging that "the claimed invention is directed to non-statutory subject matter." Office Action, p. 4. While Applicants disagree with the Examiner's characterization of the claims, to advance prosecution, Applicants have nevertheless amended claims 21-39, 41-45, 47-68, 70-78, 123, and 124.

Specifically, Applicants have amended independent claim 21 to recite, *inter alia*, "[a] computer-implemented method . . . ." Claims 22-39, 41-45, 47-49, and 123 depend from independent claim 21, and have been amended to recite, *inter alia*, "[t]he computer-implemented method . . . ."

In addition, Applicants have amended independent claim 50 to recite, *inter alia*, "[a] system for enabling users to make decisions by modeling tradeoffs between personal goals, comprising: at least one memory to store data and instructions; and at least one processor configured to access the at least one memory and, when executing the instructions, to . . . ." Claims 51-68, 70-78, and 124 depend from independent claim 50, and have been amended in a manner consistent with the amendments to

independent claim 50. Thus, claims 21-39, 41-45, 47-68, 70-78, 123, and 124 recite methods tied to specific machines.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21-39, 41-45, 47-68, 70-78, 123, and 124 under 35 U.S.C. § 101.

### **III. Rejection under 35 U.S.C. § 112, First Paragraph**

Applicants respectfully traverse the rejection of claims 21-39, 41-45, 47-68, 70-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 112, ¶ 1, for allegedly “failing to comply with the written description requirement.” Office Action, p. 5. The Examiner states that, “[t]he claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” Id. Specifically, the Examiner states that “[t]he specification does not appear to provide any support for [‘an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals’], nor has Applicant attempted to point where the claim is supported.” Id. at pp. 5-6.

Applicants respectfully disagree with the Examiner’s characterization of the claims as lacking written description in the specification. M.P.E.P. § 608.01(o) states, “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import.” Further, “[t]here is no requirement that the words in the claim must match those used in the specification disclosure.” M.P.E.P. § 2173.05(d).

Applicants respectfully direct the Examiner's attention to the specification at, for example, page 31, lines 4-24, and Figures 7 and 8. These passages, in conjunction with the figures and pending claims, provide significant written description of the subject matter of independent claims 21, 50, and 79. More particularly, these passages disclose one exemplary embodiment of "an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals," as recited in amended independent claim 21, and similarly recited in amended independent claims 50 and 79.

Applicants also direct the Examiner's attention to the specification at, for example, page 27, lines 26-27, page 28, line 27 through page 29, line 2, and Figure 5. These passages, in conjunction with the figures and pending claims, provide written description of the subject matter of dependent claims 123, 124, and 125. In particular, these passages disclose one exemplary embodiment of "generating a profile of the user based on the adjusted user preferences and personal information of the user, wherein the personal information of the user includes information relating to one or more of the age of the user, the marital status of the user, the location wherein the user resides, and a number of children of the user," as recited in amended claim 123, and similarly recited in amended claims 124 and 125.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21-39, 41-45, 47-68, 70-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 112, ¶ 1.

#### **IV. Rejection under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 50-68, 70-97, 99-103, 105-107, 124, and 125 under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Office Action, p. 6. The Examiner continues on by stating that “various ‘means for’ and ‘modules for’ are claimed without any specific enumeration in the specification of the particular structure or steps that accomplishes the stated means or modules, as required by § 112 ¶ 6.” Id.

While Applicants respectfully disagree with the Examiner’s characterization of claims 50-68, 70-97, 99-103, 105-107, 124, and 125 and reference to § 112, ¶ 6, to advance prosecution, Applicants have nevertheless amended the claims. In particular, Applicants have amended claims 50-68, 70-78, and 124 to remove the recitations of “means for,” and have amended claims 79-97, 99-103, 105-107, and 125 to remove the recitations of “module for.”

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 50-68, 70-97, 99-103, 105-107, 124, and 125 under 35 U.S.C. § 112, ¶ 2.

**V. Rejection under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 21-27, 50-56, 79-85, and 123-125 under 35 U.S.C. § 102(e) as being anticipated by Jones. A proper anticipation rejection requires that “each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131. In addition, “[t]he elements must be arranged as required by the claim . . . .” Id. (emphasis added). Applicant respectfully submits that Jones fails to disclose all of the subject matter recited in each of the independent claims 21, 50, and 79, and also fails to disclose the elements as arranged in the claims.

Specifically, Jones fails to disclose, *inter alia*,

“wherein graphically presenting the impact of the adjustment comprises displaying a plurality of images, each representing a goal, and altering the appearance of at least one of the images to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals,”

as recited in amended independent claim 21.

Instead, Jones is directed to a financial advisory system to “return scenarios for optimized portfolio allocations [which] are simulated interactively to facilitate financial product selection.” Jones, 2:49-51. According to Jones, “[b]ased on the user’s current holdings the system may forecast a retirement income and graphically depict the current portfolio’s projected growth and range of possible values over time.” Id. at 6:3-6. After an initial diagnosis is made in Jones, “[a]n iterative process may then begin in which the user may adjust his/her investment risk, savings rate, and/or retirement age and have the financial advisory system 100 evaluate the projected performance of an optimized portfolio given the financial products available to the user based on the currently selected risk tolerance, investment horizon and savings rate decisions.” Id. at 6:20-27.

While the Board, in its decision mailed February 28, 2008, (hereinafter, “Board Decision”) states that “Jones contemplates the adjustment of preferences (e.g., savings) in the attainment of goals that is *not* limited to the ‘adjustment of the *time* by which a goal would be attained’ . . .” (pp. 14-15), such a teaching of Jones does not correspond to the currently pending recitations of independent claim 21. Indeed, the Examiner fails to cite any disclosure in Jones corresponding to “wherein graphically presenting the impact of the adjustment comprises displaying a plurality of images, each representing a goal, and altering the appearance of at least one of the images to reflect an inverse



relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals,” as recited in independent claim 21. Instead, Jones only discloses “graphically depict[ing] the current portfolio’s projected growth and range of possible values over time.” Jones, 6:3-6 (emphasis added).

Accordingly, for at least the above-outlined reasons, Jones fails to disclose all of the subject matter recited in Applicants’ independent claim 21. Therefore, the rejection of independent claim 21 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn, and the claim should be allowed.

Independent claims 50 and 79, although of different scope, include recitations that are similar to those discussed above with respect to independent claim 21. Thus, for at least the same reasons as discussed in connection with independent claim 21, Jones fails to disclose all of the subject matter recited in Applicants’ independent claims 50 and 79. Therefore, the rejection of independent claims 50 and 79 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn, and the claim should be allowed.

Claims 22-39, 41-45, 47-49, and 123 depend from independent claim 21. Claims 51-68, 70-74, 79-78, and 124 depend from independent claim 50. Claims 80-97, 99-103, 105-107, and 125 depend from independent claim 79. For at least the same reasons as set forth above in connection with their corresponding independent claims, the rejection of claims 22-39, 41-45, 47-49, 51-68, 70-74, 79-78, 80-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 102(e) is legally deficient, should be withdrawn, and the claims should be allowed.

**VI. Rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 28-39, 41-45, 47-49, 57-68, 70-78, 86-97, 99-103, and 105-107 under 35 U.S.C. § 103(a) as being unpatentable over the Jones reference because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8<sup>th</sup> Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted). In addition, when "determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

In this application, a *prima facie* case of obviousness has not been established because, among other things, Jones does not teach or suggest each and every feature of Applicants' independent claim 21, from which claims 28-39, 41-45, and 47-49 depend.

As discussed above, Jones fails to disclose or suggest, *inter alia*,

“wherein graphically presenting the impact of the adjustment comprises displaying a plurality of images, each representing a goal, and altering the appearance of at least one of the images to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of one or more of the other goals,”

as recited in amended independent claim 21, from which claims 28-39, 41-45, and 47-49 depend. Instead, Jones discloses “graphically depict[ing] the current portfolio’s projected growth and range of possible values over time.” Jones, 6:3-6 (emphasis added).

Accordingly, neither Jones, nor any obvious variant thereof, discloses or suggests at least the above-noted elements of independent claim 21, from which claims 28-39, 41-45, and 47-49 depend. Therefore, independent claim 21 is nonobvious over Jones under 35 U.S.C. 103(a), and should be allowed. Claims 28-39, 41-45, and 47-49 are also nonobvious over Jones at least because of their dependence from nonobvious independent claim 21.

Claims 57-68 and 70-78 depend from independent claim 50. Claims 86-97, 99-103, and 105-107 depend from independent claim 79. Independent claims 50 and 79, although of different scope, recite elements similar to those discussed above with respect to independent claim 21. For at least the same reasons as discussed in connection with independent claim 21, the Examiner has not established *prima facie* obviousness regarding independent claims 50 and 79. Therefore, independent claims 50 and 79 are nonobvious over Jones under 35 U.S.C. 103(a), and should be allowed. Claim 57-68 and 70-78 are also nonobvious over Jones at least because of their

dependence from nonobvious independent claim 50, and claims 86-97, 99-103, and 105-107 are also nonobvious over Jones under 35 U.S.C. 103(a) at least because of their dependence from nonobvious independent claim 79.

## **VII. Conclusion**

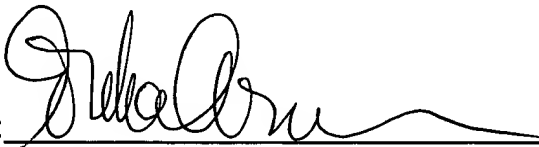
In view of the foregoing amendments and remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the cited art. Applicants therefore request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

In addition, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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